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09/992,172	11/14/2001	Nicholas F. Baida	GK-BAIDA-102/500764.20002	6892

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EXAMINER

HOOLAHAN, AMANDA J

ART UNIT

PAPER NUMBER

2859

DATE MAILED: 10/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/992,172

Applicant(s)

BAIDA, NICHOLAS F.

Examiner

Amanda J Hoolahan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2. 6) ☐ Other: \_\_\_\_

## **DETAILED ACTION**

### ***Specification***

1. The specification contains grammatical and idiomatic errors, e.g. page 4 paragraph [0011]. A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: numeral 1, 6, 39, 40a, 41, and 50. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (e) the invention was described in-
  - (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

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(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claims 1-3, 6, 12, and 14 are rejected under 35 U.S.C. 102(e) as being unpatentable by United States Patent Application Publication No. US 2002/ 0073568 A1 to Johnson (Figure 1).

Johnson discloses, in Figure 1, a device comprising a first concave shell with malleable interior sections; a second concave shell with malleable interior sections (1); adjustable connection means for connecting said first concave shell to said second concave shell thereby enclosing the case of the tape measure (24); a blade connected to at least one of said concave shells (5); a retractable blade molded into at least one of said concave shells wherein said retractable blade is molded flush within said concave shell (5); a tape measure in a case (2); a retractable cutting blade located inside said case and arranged to make cuts corresponding to measurement increments arranged on said tape measure (5); a method of making precise measured cuts on objects described as normal use of the disclosed device comprising the steps of measuring a distance using a combination tool comprising a tape measure in a case and cutting the object at said measured distance by extending a retractable blade located inside said case wherein said blade is arranged to make cuts corresponding to measurement increments arranged on said tape measure; and making a measurement mark in pencil by extending a retractable pencil lead corresponding to said measurement marks on said tape measure.

5. Claims 1 and 7 are rejected under 35 U.S.C. 102(e) as being unpatentable by United States Patent Application Publication No. US 2002/0073568 A1 to Johnson (Figure 6).

Johnson discloses, in Figure 6, a device comprising a first concave shell with malleable interior sections; a second concave shell with malleable interior sections (1); adjustable connection means for connecting said first concave shell to said second concave shell thereby enclosing the case of the tape measure (24); a tape measure in a case (2); a retractable pencil molded inside said case (27) in a flush manner and arranged to make pencil marks corresponding to measurement increments arranged on said tape measure, said tape measure including a nail hole at its exposed end.

*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2, 4, and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (Figure 6) in view of USPN 5,430,952 to Betts.

Johnson (Figure 6) discloses the device as described in paragraph 5 above.

Johnson (Figure 6) does not disclose a blade connected to at least one of said concave shells.

Betts discloses a device having a retractable blade (118) connected to at least one of said concave shells. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to add the blade, as taught by Betts, to the embodiment

shown in Figure 6 of Johnson so that the retractable pencil can mark and the blade can cut simultaneously corresponding to the measurement increments arranged on the tape measure.

8. Claims 8 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (Figure 1) in view of USPN 2,976,614 to Matuszewski.

Johnson (Figure 1) discloses the device as described in paragraph 4 above.

Johnson (Figure 1) does not disclose the said tape measure including a nail hole at its exposed end and a method of making cuts including a nail hole in said tape measure at an exposed end, inserting a nail through said nail hole into the object, and rotating said case about the nail in an arc to make a circular measured cut in the object.

With respect to claim 8: Matuszewski discloses a device comprising a tape measure including a nail hole at its exposed end. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was to add the nail hole at the exposed end of the tape measure, as taught by Matuszewski, to the tape of Johnson (Figure 1), in order to place a nail in the hole and be able to mark arcs at desired radii.

With respect to the method of claim 15: The method steps will be met during the normal operation of the device stated above, particularly since when using the device disclosed by Johnson and Matuszewski, the normal use of that device would be to insert a nail through a nail hole in the tape measure at an exposed end, and rotate the said case about the nail in an arc to make a circular cut in an object by using only one hand because the nail is holding down the free end of the tape measure.

9. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (Figure 6) in view of USPN 6,309,129 to Kageyama et al. [hereinafter Kageyama].

Johnson (Figure 6) discloses the device as described in paragraph 5 above.

Johnson (Figure 6) does not disclose the said retractable pencil being adapted to use interchangeable leads or limestone and the said retractable lead pencil being a mechanical lead pencil molded into said case in a flush manner.

Kageyama discloses a mechanical pencil having interchangeable lead. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to use the mechanical pencil, as taught by Kageyama, rather than the pencil (27), as taught by Johnson (Figure 6), so that the pencil would never need sharpening and a new lead piece could just be added by the user for easy replacement.

10. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (Figure 6) in view of USPN 6,178, 655 to Potter et al. [hereinafter Potter].

Johnson (Figure 6) discloses the device as described in paragraph 5 above.

Johnson (Figure 6) does not disclose having a clear indicator window located proximate to said tape measure, said indicator window including an index line located in line with said measurement.

Potter discloses a marking attachment for a tape measure comprising a clear indicator window (30) located proximate to said tape measure, said indicator window including an index line with said measurement increments. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to add the clear indicator

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window, as taught by Potter, to the front of the case, as taught by Johnson (Figure 6), so the user could clearly see the measurement increments on the measuring tape.

11. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson (Figure 1) in view of USPN 6,178, 655 to Potter et al. [hereinafter Potter].

Johnson (Figure 1) discloses the device as described in paragraph 4 above.

Johnson (Figure 1) does not disclose having a clear indicator window located proximate to said tape measure, said indicator window including an index line located in line with said measurement and the method of using

Potter discloses a marking attachment for a tape measure comprising a clear indicator window (30) located proximate to said tape measure, said indicator window including an index line with said measurement increments. Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to add the clear indicator window, as taught by Potter, to the front of the case, as taught by Johnson (Figure 1), so the user could clearly see the measurement increments on the measuring tape.

With respect to the method claim 13: The method steps will be met during the normal operation of the device stated above, particularly since when using the device combined by Johnson (Figure 1) and Potter, the normal use of that device would be positioning the clear window above said measurement increments to view and line up said measurement increments with an index line which corresponds to measurement increments on said tape measure so the user could clearly see the measurement increments on the measuring tape.



*Conclusion*

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. USPN 4,649,649 to Fain and USPN 3,577,641 to Smith disclose a shell casing comprising a first and second concave shell with malleable interior sections and an adjustable connection means for connecting the two shells; USPN 5,295,308 to Stevens et al. and USPN 812, 322 to Badger disclose a tape measuring device comprising a tape measure in a case with marking devices attached to at least one of the sides of the case; and USPN 5,349 to DeVito and USPN 5,435,074 to Holevas et al. disclose a tape measure in a case comprising a blade being connected to at least one of the sides corresponding to measurement increments arranged on the tape measure.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda J Hoolahan whose telephone number is (703) 305-0139. The examiner can normally be reached on Monday through Friday 8:00 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F Gutierrez can be reached on (703) 308-3875. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1782.

  
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